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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,274	01/25/2001	Werner Temme	24487	3642

7590

08/30/2004

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,274

Applicant(s)

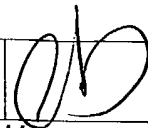
TEMME ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22 and 24-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 18-22 and 24-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims recite an "average molecular mass" without stating what type of average is being claimed, e.g. number, weight, viscosity, z, etc. It is unclear what type of average molecular mass is being claimed. Since these values may differ by a factor of up to 10-20 normally, this is a significant degree of uncertainty in the scope of the instant claims.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-22 and 24-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5959027 Jakubowski et al..

Jakubowski et al. discloses an aqueous polyurethane dispersion for coating substrates including floors. All such coated floors have the ability to have sports played on them. The patentee discloses all of the instantly claimed parameters of the polyurethane except for its molecular weight. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed molecular weight because using the components of the specified molecular weights of Jakubowski and the component amounts inferred by the disclosed NCO:OH ratio, e.g. column 3, lines 1-67, particularly lines 50-58, and column 4, lines 1-22 necessarily encompasses the instantly claimed molecular weights of some average type and

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the choice of the instantly claimed molecular weight from this range inferred by Jakubowski would have provided only predictable results such as predictable polymer viscosity by definition of viscosity average molecular weight and the predictable flowability related to such viscosity which predictably affects the ability of the polymer to be dispersed in water, to give the disclosed particle sizes, and to coalesce into a continuous film on application to the substrate. See column 2, lines 40-67; column 3, lines 1-67, particularly 50-58; column 4, lines 1-67, particularly 20-22; column 5, lines 1-7; column 6, lines 1-11, 19-33, and 56-63; column 7, lines 6-12, 16-17, and 63-65; and the remainder of the document. The prior art particle size and use of surfactant is expected to meet the limitation of the instant claim 22. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use fillers in the coating of the patentee because they are well known for use in coatings and would have been expected to give their known properties to the final coating of Jakubowski, which falls within the scope of the instant claims 24-26 and 28. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the amines of the instant claims 29, 31, 35 in the coating of the patentee because they are well known for use in polyurethanes to keep them from yellowing and are commercially available for this purpose. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the polyurethane of the patentee in accordance with the instant claim 33 because the adhesive nature of polyurethanes will necessarily give such bonding to the individual planks of flooring material conventionally used in making floors. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the coating thickness/amount of polyurethane per area of the instant claims 36-37 because this gives only predictable results to the ordinary skilled artisan and is

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within the ability of the ordinary skilled artisan to choose as evidenced by the patentee's silence to this parameter.


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 before final and (703) 872-9311 after final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

August 23, 2004


Patrick Niland
Primary Examiner
Art Unit 1714